

REMARKS

Claims 1-30 are pending in the application.

Claims 1-30 have been rejected.

The Examiner indicates that document WO 02/25464 A1 was not considered. Applicant respectfully notes that the IDS filed on 1/14/2005 indicated that the two foreign references were submitted with it, and the return postcard from the USPTO indicates that the two references were received. Unfortunately, it appears that the Office lost the reference before scanning it into the image file wrapper. Another copy of this reference is attached, and the Examiner is requested to consider it and so initial the previous IDS. A new IDS (and corresponding fee) is not believed necessary as the reference was properly cited in and submitted with an IDS nearly three years ago.

The Examiner is thanked for noting the errors in the elements numbers of Figure 1. A replacement Figure 1 is submitted, correcting the reference numbers.

A replacement Figure 2 is also submitted, moving the arrows, to alleviate the confusion expressed by the Examiner, and to add steps 265 and 270, described in the specification and claims, and as required by the Examiner. Applicant respectfully notes that as the email was already stored in the unconfirmed mailbox (at step 225), in cases where the intro-word is not received at steps 235 and 240, then the email remained stored in the unconfirmed mailbox. The objections to the drawings are believed obviated.

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A replacement Abstract is attached, which describes steps corresponding to the major limitations of the independent claims. The Examiner also appears to question the use of an incomplete sentence as the beginning of the Abstract. This is standard patent practice. The Examiner is referred to the sample abstracts shown in MPEP 608.01(b). The objection to the abstract is believed obviated.

Various amendments to the specification are made above, to address the issues raised by the Examiner and to remove transmission-type mediums from the definition of machine-usable mediums. The objections to the specification are believed obviated.

Claims 11-20 are amended to remove “means for” language. Various other claims are amended as discussed below.

Reconsideration of the claims is respectfully requested.

I. CLAIM OBJECTIONS:

With regard to claims 8, 18, and 20, the amendment to paragraph 0032 above is believed to ensure that the meaning of “obscured” is clear to those of skill in the art. Applicant notes that Figure 3 shows an example of an obscured image, and the Examiner’s art rejections make it clear that the Examiner understands clearly what is meant.

Claims 9, 19, and 29 are amended to use the phrase “non-computer harvestable form” as described and supported, *e.g.*, in paragraph 0032 of the specification as filed.

The objections to claims 7, 13, 17, and 27 are believed obviated by the amendments above.

All claim objections are therefore traversed. Accordingly, the Applicant respectfully requests the Examiner withdraw the claim objections.

II. CLAIM REJECTION UNDER 35 U.S.C. § 112, second paragraph (Indefiniteness):

Claims 1-9, 13-19 and 23-29 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter. There are two separate requirements under 35 U.S.C. § 112, second paragraph. MPEP § 2171, p. 2100-209 (8th ed., rev. 5, August 2006). The first is subjective and requires that the claims must set forth the subject matter that the *Applicants* regard as their invention. *Id.* The second is objective and requires that the claims must particularly point out and distinctively define the metes and bounds of the subject matter that will be protected by the patent grant (*i.e.*, whether the scope of the claim is clear to one of ordinary skill in the art). *Id.* at 2100-210. The Examiner should explain whether the rejection is based on indefiniteness or on the failure to claim what the Applicants regard as their invention. *Id.* (*citing Ex parte Ionescu*, 222 U.S.P.Q. 537, 539 (Bd. App. 1984)).

The rejection of claim 1, and corresponding rejections of claims 2-9 are moot in light of the amendments above.

To accommodate the Examiner's concerns about the conditional operations, the independent claims have been amended to specify that the storing occurs whenever the mail message is not delivered, and various independent claims are amended to specify conditions where delivery also occurs. In this way, the non-delivery condition is always addressed in the independent claim.

Applicant does respectfully note, however, that there is no requirement that every condition be addressed in the claims, only that one of skill in the art can understand the scope of the claims to determine possible infringement. Conditional phrases are not, in themselves, indefinite, and one of ordinary skill in the art can easily evaluate whether a conditional limitation is performed by an accused device, under the conditions specified, and thereby determine the scope of the claim and any potential infringement. Moreover, many conditional limitations, particularly in dependent claims, introduce actions that only occur when the condition is met, and there is no different action takes when the condition is not met, which is also easily and commonly understood by those of skill in the art.

The data processing system claims have been amended to remove “means for” language in favor of describing the functional configuration of the data processing system. With regard to the data processing system claims and the computer program product claims, the “if” conditionals, as used, are not indefinite at all. All claim elements are positively recited, and so must be present for infringement, and the “if” conditional is clear and definite as to the function performed by the data processing system or the instructions of the computer program product. All claims provide clear warning to others as to what constitutes infringement of the prospective patent.

It is clear that Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. The Examiner should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some

latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

All § 112 rejections are therefore traversed. Accordingly, the Applicant respectfully requests the Examiner withdraw the § 112 rejection. The undersigned requests that the Examiner telephone to resolve any remaining issues.

III. CLAIM REJECTION UNDER 35 U.S.C. § 101

Claims 21-30 were rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. This rejection is respectfully traversed.

The definition in the specification is amended to eliminate transmission-type mediums as the claimed machine-readable medium, and to this rejection is believed obviated.

Accordingly, the Applicant respectfully requests the Examiner withdraw the double patenting rejection.

IV. CLAIM REJECTION UNDER 35 U.S.C. §102

Claims 1-4, 11-14 and 21-24 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,112,227 to *Paul*, hereinafter “Paul”. This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131, p. 2100-67 (8th ed., rev. 5, August 2006) (*citing In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. *Id.* (*citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)).

The independent claims are amended to also require adding an address corresponding to a sender of the electronic mail message to a list of valid senders if the email includes the intro-word, as supported in the specification as filed. This is not taught or suggested by Paul, and so the anticipation rejections are moot and are traversed.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102 rejection with respect to these claims.

V. CLAIM REJECTION UNDER 35 U.S.C. § 103

Claims 5-10, 15-20 and 25-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,112,227 to *Paul*, hereinafter “Paul” in view of U.S. Patent No. 5,999,932 to *Heiner*, hereinafter “Heiner”. The Applicant respectfully traverses the rejection.

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a *prima facie* case of obviousness. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). See also *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984)). It is incumbent upon the examiner to establish a factual basis to support the legal

conclusion of obviousness. (*Id.* at 1073, 5 USPQ2d at 1598). In so doing, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007))).

Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. MPEP § 2142, p. 2100-125 (8th ed. rev. 5, August 2006). To establish a *prima facie* case of obviousness, three basic criteria must be met: *Id.* First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *Id.*

The independent claims are amended to also require adding an address corresponding to a sender of the electronic mail message to a list of valid senders if the email includes the intro-word, as supported in the specification as filed. This is not taught or suggested by Paul or Heiner, or any combination of them, and so the obviousness rejections are also moot and are traversed. Applicant

notes that Heiner does consider an “accept list”, but does not consider adding senders to the accept list based on an intro-word as claimed, but rather requires a manual “registration” process.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 103 rejection with respect to these claims.

All rejections are traversed.

CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining claims in the Application are in condition for allowance, and respectfully requests that this Application be passed to issue.


If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *manderson@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 05-0765.

Respectfully submitted,

MUNCK BUTRUS CARTER, P.C.

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